

at least 10 kelvins above $T_g^{(1)}$ in the aqueous dispersion of the polymer P1, at least one **chain transfer reagent**¹ being used **either** in the polymerization of the monomer charge M1 **or** in the polymerization of the monomer charge M2 (emphasis added).

The rejection of Claims 1, 4, 5, 7-9, 11-14, 20, 21, 23 and 24 under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over, U.S. 5,643,993 (Guerin), is respectfully traversed. Guerin discloses aqueous polymer dispersions containing a structured particle consisting of a core of a first polymer and a shell of a second polymer (paragraph bridging columns 4 and 5). While, as the Examiner points out, Guerin discloses that polymerization to form their respective polymers may be carried out in the presence of at least one chain transfer reagent (column 6, lines 21-24), Guerin neither discloses nor suggests the use of at least one chain transfer reagent for making one, and only one, of the respective polymers. Indeed, as disclosed in all of the examples therein, a chain transfer reagent (N-dodecanethiol) is used for making each of the first and second polymers (column 10, lines 1-45).

The advantage of employing a chain transfer reagent in the preparation of one, as opposed to both, polymers is demonstrated in the specification herein. Comparative Example 1 demonstrates Dispersion c-1, which was made without the use of a chain transfer reagent for either of the polymers. On the other hand, Examples 1-8 are according to the presently-claimed invention. See Table 1 at page 21 of the specification. The comparative example and examples were formulated into paints and tested for various properties, as described in the specification beginning at page 22 through page 25, line 10. The results are shown in

¹The terms "chain transfer reagent" and "chain transfer agent" have been used synonymously herein.

Table 2 at page 25 of the specification. Applicants describe the results in the specification at page 25, last four lines, as follows:

From the examples it is evident that the polymer dispersions 1 to 8 of the invention result in paints having improved scrub resistance and enhanced gloss, while the blocking resistance and viscosity of the paints remain largely unaffected.

The above-discussed results could not have been predicted from Guerin.

The Examiner relies on the reasons of record. Thus, the Examiner finds that Guerin discloses the use of "**at least**" (emphasis by the Examiner) one chain transfer agent (column 6, lines 21-24), from which the Examiner infers that Guerin discloses an embodiment wherein a chain transfer agent is used in the production of one and only one of the first polymer and second polymer. In reply, Applicants respectfully submit that a person skilled in the art would interpret the disclosure in Guerin that his process can be carried out in the presence of at least one chain transfer agent as suggesting either using at least one chain transfer agent for both of the polymerizations, or none of the polymerizations. There is simply no objective disclosed in Guerin which would be furthered by using a chain transfer agent for only one of the polymerizations.

As stated in *In re Arkley*, 172 USPQ 524, 526 (CCPA 1972):

[R]ejections under 35 U.S.C. 102 are proper only when the claimed subject matter is identically disclosed or described in "the prior art." Thus, for the instant rejection under 35 U.S.C. [102(b)] to have been proper, the . . . reference must clearly and unequivocally disclose the claimed [subject matter] or direct those skilled in the art to the [subject matter] without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference. Such picking and choosing may be entirely proper in the making of a 103, obviousness rejection, where the applicant must be afforded an opportunity to rebut with objective evidence any inference of obviousness which may arise from the similarity of the subject matter which he claims to the prior art, but it has no place in the making of a 102, anticipation rejection.

At best, Guerin is available under § 103 only. In such a case, the comparative data of record must be considered. This data is shown in Table 2 at page 25 of the specification, a copy of which is reproduced below (without the footnotes):

Dispersion	Scrub resistance [μm]		Gloss		Block resistance				Viscosity	
			@20°	@60°	B1	B2	B3	B4	LS	HS
C1	830	39	60	85	8	8	8	7	86	1.6
1	880	37	69	88	8	8	7	7	88	1.6
2	1050	36	69	88	8	8	7	7	87	1.6
3	935	38	71	89	8	8	7	7	88	1.7
4	970	36	70	88	8	8	4	7	85	1.6
5	1360	37	64	87	8	8	7	7	88	1.6
6	1340	39	68	87	8	8	8	7	88	1.6
7	1180	38	67	86	7	8	3	3	88	1.6
8	1600	37	70	90	8	8	2	4	84	1.5

Clearly, the prior art has recognized no nexus between the presence or absence of a chain transfer agent, and the properties of scrub resistance and gloss, while blocking resistance and viscosity remain largely unaffected.

In the Advisory Action of August 27, 2002, the Examiner found that Dispersion C1 and Dispersion 1 "have yielded almost [the] same results." In reply, Table 2, reproduced above, shows that both scrub resistance and gloss of a coating can be improved by using Dispersion 1 as a binder instead of Dispersion C1. When taking the smaller dry film thickness of the coating obtained from Dispersion 1 into account, the increase in scrub resistance is greater than 10%. Moreover, the gloss at an observation angle of 20° is similar to the gloss obtained for the other coatings according to the invention, but markedly greater

than for a coating obtained from Dispersion C1. Regarding the above-discussed scrub resistance increase of greater than 10%, the values in Table 2 must be corrected for dry film thickness. It is evident that the thicker the film is, the higher is the scrub resistance. As shown, the film of Dispersion C1 has a thickness of 39 μm and a scrub resistance of 830 cycles, while the film of Dispersion 1 has a thickness of 37 μm and a scrub resistance of 880 cycles. Therefore, the increase is not only 6% as indicated by the integers 830 and 880, but exceeds 10% when taking the film thickness into account.

In the Advisory Action of August 27, 2002, the Examiner also found that the polymers of the claimed dispersions without a chain transfer reagent and those of Guerin with a chain transfer reagent "would be [the] same." In reply, compounds having different properties are not the same compounds. It can be seen from the data in Table 2 that the chain transfer reagent affects the properties of the coatings, which stem from the properties of the polymeric binder. It can also be seen that the properties of the coatings depend on whether the chain transfer reagent is employed in the first or in the second step. Compare Examples 1-4 with Examples 5-8.

In addition to the comparative data in the specification, the Zhao Declaration of record provides further evidence of patentability. The Zhao Declaration clearly shows that the use of the chain transfer reagent in either the first or the second polymerization steps (but not in both) yields polymers having superior application properties compared to polymers wherein the chain transfer reagent is used in both polymerization steps or in neither polymerization steps. As the Table at page 4 of the Zhao Declaration shows, polymer latex V1 (erroneously labeled as VD1 in the Table) was obtained without using any chain transfer reagent; polymer latices V2 and V3 were obtained using a chain transfer reagent for both polymerizations. Zhao concludes in the paragraph bridging pages 5 and 6 as follows:

As can be seen from the comparative results of the latices (D1 and D2, according to the present invention, versus V1), the use of a chain transfer agent in the 1st polymerisation stage results in paints which show increased gloss and have only slightly reduced block resistance. As can be seen from the comparative results of the three pairs of latices (D1, according to the present invention, versus V2, D2, according to the present invention, versus V3 and D3, according to the present invention versus V2), the use of a chain transfer agent in both stages at total levels equal to that used in the first stage (or in the second stage) result in detrimental effects on gloss. The use of a chain transfer agent in the 2nd polymerisation stage results in polymer latices showing reduced gloss compared to latices wherein the chain transfer agent is used in the 1st polymerisation stage (D1 versus D3). However, when the chain transfer agent is used in the 2nd polymerisation stage, the scrub resistance is higher than either the case where no chain transfer agent is used (V1) or the case where the chain transfer agent is used in both stages (D3 versus V2 or V3). The higher scrub resistance associated with the use of a chain transfer agent in the 2nd stage can also be clearly seen from table 2 on page 25 of Ser. No. 09/702,724 [i.e., the present application]. Therefore the use of a chain transfer agent in either the 1st stage or the 2nd stage of the emulsion polymerisation, leads to better properties compared to those latices obtained by emulsion polymerisations without any chain transfer agent or with the chain transfer agent distributed in both stages.

New Claims 19-29 are separately patentable. These claims require that the weight ratio of the monomers present in the monomer charge M1 to the monomers present in the monomer charge M2 be, in effect, at least 2:1, i.e., polymer phase P1 is present in an amount of at least 67% of the total amount. In Guerin, on the other hand, the first or core polymer is present in a maximum amount of 65% of the total (column 5, lines 56-59). The Examiner apparently agrees with regard to Claim 25 (and Claim 6), which he finds allowable.

In the present Office Action, the Examiner, in effect, dismisses all of the above arguments, simply finding that the comparative data of record is not against the closest prior art, since it does not compare to any of the examples of Guerin, and that even if the comparative data had any probative value, the scope of the presently claimed invention is broader. The Examiner further finds that Applicants fail to show that the first polymer of

Guerin obtained in the presence of chain transfer agent does not have the recited molecular weight.

In reply, there is nothing in patent law precedent that requires that comparison to the closest prior art be a comparison to the **exact examples** of the closest prior art reference. The examples of Guerin employ a chain transfer reagent in both a first polymer phase polymerization and a second polymer phase polymerization. Applicants have compared such two-step polymerizations wherein the only difference is in the use or non-use of the chain transfer reagent in the respective steps. The Examiner has not explained why such data is not sufficient to demonstrate the argued distinction between the present invention and the prior art, i.e., the use of at least one chain transfer reagent either in the first polymerization or the second polymerization, but not both. Nor has the Examiner explained why the comparative data of record is not sufficient to demonstrate that the use of a chain transfer reagent, as in the present invention, affects properties of, for example, paints containing the polymer dispersions, such as improved scrub resistance and enhanced gloss, while blocking resistance and viscosity of the paints remain largely unaffected. Nor is it relevant whether the molecular weight obtained by Applicants using a chain transfer reagent is the same as or overlaps that of any of the polymers of Guerin using a chain transfer reagent. In the present invention, the polymer phase obtained in the presence of the chain transfer reagent will necessarily have a lower molecular weight than the polymer phase obtained in the absence of the chain transfer reagent.

For all the above reasons, it is respectfully requested that the rejection over Guerin be withdrawn.

The rejection of Claims 1, 4, 5, 7-24 and 26-29 under 35 U.S.C. §103(a) as unpatentable over Guerin alone, or in view of U.S. 5,804,676 (Hieda et al), is respectfully

traversed. The disclosure and deficiencies of Guerin have been discussed above. Hieda et al do not remedy these deficiencies. Hieda et al is based on a finding that most of a volatile content can efficiently be removed from a polymer composition by continuously feeding, to a polymerization reactor, a material solution comprising a specific amount of methanol as a solvent, methyl methacrylate alone or a monomer component comprising methyl methacrylate and an alkyl acrylate, a chain transfer agent and a polymerization initiator to carry out polymerization, continuously drawing a part of a polymerizate, heating it, and then feeding it onto a screw of an extruder through a feed opening substantially maintained at atmospheric pressure. In addition, it has also been found that a high-quality polymer which is usable as a molding material can be prepared without troubles such as coloring, while a high productivity is stably kept by removing the remaining volatile content from the polymer composition at a downstream vent, and then extruding the same (column 3, lines 43-58). Hieda et al disclose the formation of a polymer having a weight average molecular weight in the range of 80,000 to 200,000 (column 6, lines 20-23). The Examiner particularly relies on the disclosure in Hieda et al that if the concentration of the chain transfer agent is too high, the weight average molecular weight of the product is less than 80,000 (column 9, lines 44-47).

This disclosure in Hieda et al simply reflects the common knowledge of what a chain transfer agent does. But no motivation is provided by Hieda et al to produce Guerin's product such that one of Guerin's polymers has a weight average molecular weight above 80,000, and another has a weight average molecular weight below 80,000. Nor does Hieda et al disclose or suggest producing one of the polymers in the presence of a chain transfer agent, and the other polymer in the absence of a chain transfer agent.

In the present Office Action, the Examiner notes that Guerin discloses that his process can be carried out in the presence of "up to" approximately 1 part by weight . . . of at least

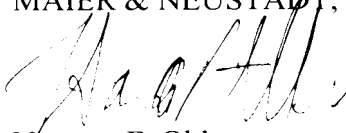
one chain transfer agent (column 6, lines 21-24), and finds that the quoted term includes zero, relying on *In re Mills*, 477 F2d 649, 176 USPQ 196 (CCPA 1972) for the proposition that a disclosure is not limited to its preferred embodiments. However, even if "up to" would be interpreted as inclusive of zero, and Applicants do not admit that it would, Guerin, considered as a whole, would not, as argued above, be interpreted as disclosing or suggesting using a chain transfer reagent for only one of his first polymer and second polymer.

For all the above reasons, it is respectfully requested that the rejection over Guerin in view of Hieda et al be withdrawn.

Applicants gratefully acknowledge the Examiner's indication of allowability of Claims 6 and 25. Nevertheless, Applicants submit that all of the presently pending claims in this application are in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Norman F. Oblon
Attorney of Record
Registration No. 24,618

Harris A. Pitlick
Registration No. 38,779



22850

(703) 413-3000
Fax No.: (703) 413-2220